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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,673	01/29/2004	George Hadley Callaway	9417.17685-DIV	5417
26308	7590	02/03/2006		
RYAN KROMHOLZ & MANION, S.C. POST OFFICE BOX 26618 MILWAUKEE, WI 53226			EXAMINER MILLER, CHERYL L	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/767,673	Applicant(s) CALLAWAY ET AL.	
	Examiner Cheryl Miller	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3 and 5 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Attachment #1</u>                      |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 12, 2005 has been entered.

### ***Response to Arguments***

Applicant's arguments with respect to claims 2-5 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

Claim 2 is objected to because of the following informalities: lines 13-14 are unclear at, "the second member being sized and configured to not move in concert with either of the first and second members". It is unclear how the second member does not move with the second member. It seems as maybe the applicant intended to recite a third member, instead of a second member. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Alby (US 6,241,730 B1, cited in IDS). Alby discloses an assembly (see fig.4) comprising a prosthesis (10 may be considered a prosthesis; or “implant” disclosed at col.2, lines 65-67), a support (4B/4Ba) having a supporting surface (outer surface of 4Ba), a mount (8) including a mounting surface (8a+8b), the mount (8) adapted to permit movement relative to the supporting surface (4Ba; see fig.1), a series of sequentially stacked members (12, 12, and 12 in fig.4) including a first member (12) carried by the mount, and permitting relative movement between the first member and mount (upon compression, relative movement will occur), a second member (12) stacked above the first member, and permitting relative movement between the first and second member (upon compression, relative movement will occur) and a third member (12) stacked above the second member permitting relative movement between the second and third member, the first and third members being sized and configured to move in concert (both are angled in the same direction and will move in the same manner upon compression) and the second member being sized and configured to not move in concert with the first and third members (the second member is angled in a different direction than the first and third members and will move in a different manner upon compression), and a locking mechanism (lock 9 screws in; or member 11 which compresses members 12) adapted to compress the members in a first mode (when screwed tight) and in a second mode (when unscrewed) to allow movement of the mount (8) on the support surface (4Ba).

Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Phillips et al. (US 6,887,279 B2). Phillips discloses an assembly (see figs.50-52 and 55) comprising a prosthesis

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(foot 218), a support (outer pylon 220) having a supporting surface (inner surface), a mount (inner pylon 222) including a mounting surface for the prosthesis (bottom surface near 252), the mount (222) adapted to permit movement relative to the supporting surface (220), a series of sequentially stacked members (260, 260, 260) including a first member (bottom 260) carried by the mount (222), and permitting relative movement between the first member and mount (upon compression, relative movement will occur), a second member (another 260) stacked above the first member (260), and permitting relative movement between the first and second member (upon compression, relative movement will occur) and a third member (another 260) stacked above the second member (260) permitting relative movement between the second and third member, the first and third members being sized and configured to move in concert (both are angled in the same direction and will move in the same manner upon compression) and the second member being sized and configured to not move in concert with the first and third members (the second member is angled in a different direction than the first and third members and will move in a different manner upon compression), and a locking mechanism (230 or 270) adapted to compress the members in a first mode and in a second mode to allow movement of the mount (222) on the support surface (220).

Claims 2, 3, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Brett (US 6,409,766 B1). Brett discloses an assembly comprising a prosthesis, a support having a supporting surface, a mount including a mounting surface for the prosthesis, the mount adapted to permit movement relative to the supporting surface, a series of sequentially stacked members including a first member carried by the mount, and permitting relative movement between the

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first member and mount, a second member stacked above the first member, and permitting relative movement between the first and second member and a third member stacked above the second member permitting relative movement between the second and third member, the first and third members being sized and configured to move in concert and the second member being sized and configured to not move in concert with the first and third members, and a locking mechanism (34a) adapted to compress the members in a first mode and in a second mode to allow movement of the mount on the support surface (see attachment 1).

Brett discloses one member adapted to move in concert with the supporting surface and not the mount, and another member adapted to move in concert with the mount and not the supporting surface (see attachment 1). Brett discloses one member having a marginal edge *adapted to be free* from the interior margin of the mount, which moves in concert with the supporting surface and not the mount (see attachment 1).

#### ***Allowable Subject Matter***

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Miller



**BRUCE SNOW**  
**PRIMARY EXAMINER**

# Attachment #1 (marked up)

U.S. Patent

Jun. 25, 2002

Sheet 1 of 10

US 6,409,766 B1

